

been on vacation may reply to a message requesting certain information only to find out that another member of his or her department has already provided the information and sent it out to all recipients of the original message. Thus, when the user has a large backlog of electronic mail messages, time may be wasted in replying to messages because, as it eventually turns out, such a reply is actually unnecessary.

As pointed out in the previous response, the primary reference, the Nielsen patent deals with a much different problem than that described above and specifically concerns a system for reminding a sender of an e-mail if the recipient of the e-mail does not respond by a selected time set by the sender. The system permits the sender of a message to designate whether the sender wishes to be warned in the case that the message is not opened by the recipient prior to a time and date specified by the sender. The system automatically monitors incoming messages and updates a database of such messages as those messages are received from message recipients. If a response is not received from a recipient prior to the specified time and date, the system generates a warning message to the sender.

With this background, it is again respectfully submitted that a system for warning the sender of e-mail messages when replies to the messages are not received has nothing to do with, and has no application to, the problem solved by the present invention, i.e., correlating an electronic message with a related (e.g., reply or forwarded) electronic message by checking for reply (e.g., forwarded) messages relating to the original electronic mail message and received by the user after receipt of the original message.

The secondary reference, the Knowles et al patent, is concerned with finding an e-mail message to which another e-mail message is responsive, and is particularly concerned with using textural context and characteristics of messages in order to provide a more reliable and effective way to construct "message threads," wherein "a thread" is defined as a "conversation among two or more participants carried out by an exchange of messages."

In the Knowles reference, statistical information retrieval techniques are used in conjunction with textural material obtained by "filtering" of the messages so as to improve the level of accuracy and to identify when one message is in reply to another. Again, it is respectfully submitted that this problem has nothing to do with the problem addressed by the primary reference, i.e., that of reminding or warning a sender of an e-mail when the e-mail recipient does not respond within a set time period. Accordingly, it is respectfully submitted that the combination proposed by the Examiner is necessarily the improper product of hindsight.

Further, in this regard, the Examiner contends that it "would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the search features as taught by Knowles, into the e-mail system of Nielsen, for the purpose of creating an effective message threading system." However, the Nielsen patent has nothing to do with message threading and, as is set forth above, is concerned instead with tracking messages that have been sent out so as to warn the sender if a recipient has not responded within a predetermined time.

Given the actual teachings of Nielsen, why would a routineer, i.e., one of ordinary skill in the art, considering the Nielsen system, which is concerned with the

determination of whether an intended recipient for an e-mail actually received the e-mail, be motivated to “create an effective message threading system” when a message threading system is not necessary to make the Nielsen more effective in carrying out its primary purpose of determining whether an intended recipient actually got the e-mail by monitoring the receipt of “acknowledge” responses? The answer is that the routineer would not. It is also noted that the Nielsen system is concerned with detecting the presence of a single responsive e-mail from the recipient, most likely in the form of an “acknowledgement” e-mail, but also possibly a single responsive e-mail with the same subject line, so that it is clear that Nielsen is not concerned with the tracking of e-mails and responses. In this regard, it is respectfully submitted that Nielsen is ultimately concerned with verifying that the e-mail has been received and opened by the intended recipient, and whether or not the recipient actually responds is secondary.

Turning to the claims and considering independent claim 1, it is respectfully submitted that the references do not disclose a method for responding to an e-mail message selected by a user wherein the user accesses a mailbox to store one or more electronic messages each having a unique identifier and identify a storage field and wherein the method includes retrieving the unique identifier of the selected electronic mail (e-mail) message, searching the mailbox for at least one related e-mail message having the unique identifier of the selected message in the identifier storage field of the related message, and providing information relating to the results of searching the mailbox step for at least one related e-mail message of the character set forth.

The Examiner states that the Nielsen patent discloses the invention “substantially as claimed,” but it is respectfully submitted that, as is implicitly acknowledged by the

Examiner, the Nielsen patent does not teach key features of the present invention, and, as set forth above, actual relates to a much different subject matter. Moreover, as set forth above, the Knowles et al patent also relates to a different problem from that addressed and solved by the present invention and, in this regard, employs highly sophisticated information retrieval techniques for recognizing and manipulating threads contained in electronic messages. Thus, it is respectfully submitted that it would not be obvious to combine the Nielsen and Knowles et al references and that, moreover, no fair combination of these references would result in the present invention as claimed in claim 1. Similar remarks apply to claims 10, 18 and 21.

It is respectfully submitted that the dependent claims also set forth further features which are not disclosed in the references and are separately patentable. For example, claim 6 and 7, 8 and 9, 15, 16 and 17, 20, 22 and 23 all relate to a feature that is simply not disclosed by the references. This features concerns determining which of the related mail messages has the latest sent time in the time field provided in the e-mails. For example, claim 15 recites that each electronic mail message further comprises a time field for storing a sent time, and that the receiving information step further comprises the step of determining which related e-mail messages has the latest sent time in the time field. It will be appreciated that, in the example referred to above, it is important for the user to be able to determine the last sent related message so as to avoid sending other replies that may have been rendered unnecessary by the last sent message, i.e., wherein the last sent message supercedes or otherwise renders unnecessary a contemplated further reply.

In connection with these claims, the Examiner takes the position that the claims are met by the cited patents and makes particular reference to the Nielsen patent at column 1, line 11 to column 2, line 30 and column 3, line 8 to column 4, line 31.

Although these lengthy passages of the Nielsen patent have been carefully reviewed, it is not seen that there is any teaching therein of the features in question. Nielsen patent is, of course, concerned with logging times, but this is in connection with determining whether a reply has been received from a recipient of the e-mail sent by the sender within a pre-selected time period set by the sender, and once a response has been received, the inquiry is ended. Accordingly, in the Nielsen patent, there is simply no provision for any comparison of sent times in order to determine the latest sent time, since this would not be necessary with the Nielsen system.

In responding to the arguments previously presented by Applicant, the Examiner cites a case in support of the proposition that so long as a reconstruction "takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made, and does not include knowledge gleaned only from Applicant's disclosure, such a reconstruction is proper." Of course, Applicant has no quarrel with this statement of the law but respectfully notes that the Examiner has not demonstrated that the basis for the proposed reconstruction is that set forth in the quoted materials, i.e., only knowledge that was within the level of ordinary skill in the art at the time the invention was made and not including knowledge gleaned only from the present application.

The second point raised by the Examiner is that "a recitation of intended use of the claimed invention must result in a structural difference the claimed invention and the

prior art in order to patentably distinguish the claimed invention from the prior art." It is respectfully submitted that while, again, this quoted material is good law, the Examiner has missed the point being made here. The argument here is not whether the claims are relying on the intended use of the invention in distinguishing over the prior art but whether given the actual teachings of the two references, i.e., the "intended uses" with which the references are concerned, the combination of the two references is a proper one.

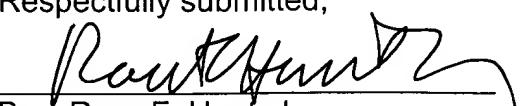
The Examiner states that "Nielsen was relied on for the mailbox and unique identifier" and that "Knowles was relied on for finding related messages in the mailbox based on unique identifiers" and concludes that the "two features are functionally complementary in the art of electronic mail processing." It is respectfully submitted that this conclusion does not answer the argument being advanced by Applicant. The teachings of the references must be taken in context and an Examiner cannot simply pick and choose teachings from a reference without regard to the context of these teachings.

Finally, the Examiner has not addressed the arguments made above with respect to claims 15, 16 and 17 and the related claims mentioned above but has simply repeated the original rejection without explaining why the passages cited are thought to disclose the subject matter in question. It is respectfully submitted that these passages do not disclose the claimed subject matter here and thus it is requested that the Examiner specifically point out what portions of the very lengthy passages cited are believed to anticipate the particular features of the invention being claimed in these claims.

Allowance of the application in its present form is respectfully solicited.

Respectfully submitted,

Date: February 17, 2005

  
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**ATTACHMENT A**  
**Amendments to the Claims**

*This is a list of claims already on file, no current amendments have been made.*

1. (Original) A method for responding to an electronic mail message selected by a user, where the user accesses a mailbox adapted to store one or more electronic mail messages, each electronic mail message having a unique identifier and an identifier storage field, the method comprising the steps of:
  - retrieving the unique identifier of the selected electronic mail message;
  - searching the mailbox for at least one related electronic mail message having the unique identifier of the selected electronic mail message in the identifier storage field of said related electronic mail message; and
  - providing information relating to results of said searching the mailbox step.
2. (Original) The method of claim 1, further comprising the step of displaying to the user said information relating to said results of said searching the mailbox step.
3. (Original) The method of claim 2, wherein said displaying step is executed in response to a request from the user to respond to the selected electronic mail message.
4. (Original) The method of claim 1, wherein said information relating to said results of said searching the mailbox step comprises a count of said related electronic mail messages found in said searching the mailbox step.
5. (Original) The method of claim 1, wherein said information relating to said results of said searching the mailbox step comprises the unique identifier of each said related electronic mail message found in said searching the mailbox step.

6. (Original) The method of claim 1, wherein each electronic mail message further comprises a time field for storing a sent time, and wherein said searching the mailbox step further comprises the step of searching the time field of each said related electronic mail message for a sent time later than the sent time of the selected electronic mail message.
7. (Original) The method of claim 6, wherein said information relating to said results of said searching the mailbox step comprises data relating to results of said searching the time field step.
8. (Original) The method of claim 6, wherein said searching the mailbox step further comprises the step of determining which said related electronic mail message has a latest sent time in the time field.
9. (Original) The method of claim 8, wherein said information relating to said results of said searching the mailbox step comprises data relating to results of said determining step.
10. (Previously Presented) A method for generating a response to a first electronic mail message received by a user, the first electronic mail message being received from a mailbox associated with the user and adapted to store one or more electronic mail messages, each electronic mail message having a unique identifier and an identifier storage field, comprising the steps of:
  - receiving a request from the user to respond to the first electronic mail message;
  - retrieving the unique identifier of the first electronic mail message;
  - receiving information about related electronic mail messages stored in the mailbox and determined from a search of the mailbox to be sent in response to the first electronic mail message based on the unique identifier of the first electronic mail message; and
  - displaying said information to the user.

11. (Original) The method of claim 10, wherein said related electronic mail messages are determined to be sent in response to the first electronic mail message if the unique identifier of the first electronic mail message is stored in the identifier storage field of said related electronic mail message.

12. (Original) The method of claim 10, wherein said information displayed to the user comprises a count of said related electronic mail messages.

13. (Original) The method of claim 10, wherein said information displayed to the user comprises a listing of said related electronic mail messages, wherein said listing includes at least one of a sender, a recipient, a subject, a sent time, and a message body.

14. (Original) The method of claim 10, further comprising the steps of:  
generating a reply electronic mail message to said first electronic mail message,  
said reply electronic mail message comprising a reply identifier storage field; and  
storing the unique identifier of the first electronic mail message in said reply identifier storage field of said reply electronic mail message.

15. (Original) The method of claim 10, wherein each electronic mail message further comprises a time field for storing a sent time, and wherein said receiving information step further comprises the step of determining which said related electronic mail message has a latest sent time in the time field.

16. (Original) The method of claim 15, further comprising the step of highlighting to the user said related electronic mail message having the latest sent time in the time field.

17. (Original) The method of claim 15, further comprising the step of opening for the user said related electronic mail message having the latest sent time in the time field.

18. (Original) A computer readable medium having embodied thereon a computer program, the computer program being executable by a machine to perform a method for responding to an electronic mail message selected by a user, where the user accesses a mailbox adapted to store one or more electronic mail messages, each electronic mail message having a unique identifier and an identifier storage field, the method comprising the steps of:

retrieving the unique identifier of the selected electronic mail message;

searching the mailbox for at least one related electronic mail message having the unique identifier of the selected electronic mail message in the identifier storage field of said related electronic mail message; and

providing information relating to results of said searching the mailbox step.

19. (Original) The computer readable medium of claim 18, further comprising the step of displaying to the user said information relating to said results of said searching the mailbox step.

20. (Original) The computer readable medium of claim 18, wherein each electronic mail message further comprises a time field for storing a sent time, and wherein said searching the mailbox step further comprises the steps of:

searching the time field of each said related electronic mail message for a sent time later than the sent time of the selected electronic mail message; and

determining which said related electronic mail message has a latest sent time in the time field.

21. (Previously Presented) A computer readable medium having embodied thereon a computer program, the computer program being executable by a machine to perform a method for generating a response to a first electronic mail message received by a user, the first electronic mail message received from a mailbox associated with the user and

adapted to store one or more electronic mail messages, each electronic mail message having a unique identifier and an identifier storage field, comprising the steps of:

receiving a request from the user to respond to the first electronic mail message;

retrieving the unique identifier of the first electronic mail message;

receiving information about related electronic mail messages stored in the mailbox and determined from a search of the mailbox to be sent in response to the first electronic mail message based on the unique identifier of the first electronic mail message; and

displaying said information to the user.

22. (Original) The computer readable medium of claim 21, wherein each electronic mail message further comprises a time field for storing a sent time, and wherein said receiving information step further comprises the step of determining which said related electronic mail message has a latest sent time in the time field.

23. (Previously Presented) The computer readable medium of claim 21, wherein said related messages comprise previously forwarded messages having sent times and forwarded in response to the first electronic mail message and said steps further include determining the related forwarded message having the latest sent time.